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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,116	03/24/2004	Anders Berndtsson	2838	4522

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EXAMINER

COLILLA, DANIEL JAMES

ART UNIT PAPER NUMBER

2854

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,116

Applicant(s)BERNDTSSON ET AL. **Examiner**

Daniel J. Colilla

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2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) 14-23 and 25-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 1-3 and 24 in the reply filed on 5/16/05 is acknowledged. The traversal is on the ground(s) that, "present invention defined in claim 1 can be performed on the apparatus as defined in claim 53, and when the apparatus defined in claim 53 is utilized the method defined in claim 1 can be performed. This is not found persuasive because applicant has not applied the appropriate test for determining whether a restriction is proper. The appropriate test is (reprinted here from the restriction requirement),

"(1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process."

In this case Examiner Eickholt noted that the process as claimed can be practiced by hand. Thus the requirement for restriction is fulfilled. It is also noted here that the apparatus as claimed can be used for drying or hardening the ink which is not a step recited in the claim, thus the apparatus can be used to practice another and materially different process.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

2. Claims 13 and 24 are objected to because of the following informalities:

In claim 13, "their transporting path" has no antecedent basis in the claims. This claim does not depend from claim 12, in which the transporting path was previously recited.

In claim 24, "the treatment stage" has no proper antecedent basis in the claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-13 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 4-5, applicant recites, "treating the information carriers on the surface so that the surface is well wetted." This, however, does not appear to be accurate. It does not appear that the surface is well wetted by the treatment process, rather, the surface appears *to be prepared* for wetting by the treatment process since no fluids are applied to the surface during the treatment process. For purposes of examination the claim will be interpreted to mean that the surface is treated so that it is prepared to be "well wetted."

In claim 13, the phrase "at least one processing unit which performs the treatment" is confusing. It is not clear if applicant is reciting the same processing unit or a different one that that which is recited in claim 1. If it is intended to be the same, it is noted that the processing unit does not perform the treatment according to claim 1. For purposes of examination, this claim will be interpreted as reciting, --at least one processing unit which performs printing.--

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-9, 11-13 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Jennel (US 6,135,654).

With respect to claim 1, Jennel discloses a method for producing information carriers including the steps of:

- transporting the information carriers 26 with conveyor mechanism 42
- processing a surface of the information carriers 26 by a processing unit 44, and
- treating a surface of the information carriers (Jennel, col. 5, lines 18-25) by a pre-treatment device 60 as shown in Figure 6A. In col. 5, lines 21-25, Jennel states that “the pre-treatment. . .increases the surface energy of the bottle to allow for a greater chemical bond between the surface of the bottle 26 and the ink. Thus the surface’s ability is prepared to be “well wetted.”

With respect to claim 2, as mentioned above, the pre-treatment increases the wettability with ink.

With respect to claim 3, as mentioned above, Jennel discloses that, “the pre-treatment. . .increases the surface energy of the bottle” (col. 5, lines 21-25).

With respect to claim 4, since the increased surface energy allows the ink to bond with the surface of the bottle 26 rather than bead up and resist the bottle, it must inherently have a greater energy than the surface tension of the ink.

With respect to claims 5, 6, 7, 9 and 11, the treating step can include treatment by flame, corona or plasma. At least the corona treatment inherently results in oxidation and ionization of

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the surface. Reference can be made to Tazikawa (JP 11-263006) for more detail about the inherency (see machine translation, paragraph [0049]).

With respect to claim 8, treatment by a flame as mentioned above will result in thermal treatment.

With respect to claim 12, Figure 6 of Jennel shows that conveyor 42 defines a transporting path along which the information carriers 26 are transported. Treatment device 60 defines a treatment state on this transporting path.

With respect to claim 13, Jennel discloses a transporting path as mentioned above. Figure 6 further shows that the path leads the information carriers 26 to the processing unit 44 which performs printing on the information carriers 26.

With respect to claim 24, the processing unit 44 includes a treatment stage which serves for printing of the surface of the information carriers 44.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jennel (US 6,135,654) as applied to claims above, and further in view of Oresti et al. (US 5,223,852).

Jennel discloses the method for producing information carriers except that it is not known to the examiner if the flame used is a gas flame. However, Oresti et al. teaches treating

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information carrier surfaces, before being processed, with gas flame means 10 (col. 2, lines 36-40). It would have been obvious to combine the teaching of Oresti et al. with the method disclosed by Jennel for the advantage of a flame fuel supply that is clean and easily transported.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schmitt et al., Kiguchi et al. and Yamazaki et al. are cited to show other examples of methods of producing information carriers with treating steps for improving wettability and printing steps.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 14, 2005



Daniel J. Colilla
Primary Examiner
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